

REMARKS/ARGUMENTS

Claims 1-7, 9-18, and 20-34 were previously pending. As noted above, claims 1, 4, 5, 7, 12, 15, 16, 23, 24, 29 and 34 have been amended, claims 2, 3, 8, 13, 14, 19, 26, 30 and 31 have been canceled, and claims 35 - 39 have been added. Support for these amendments may be found throughout the Specification.¹ Thus, claims 1, 4-7, 9-12, 15-18, 20-25, 27-29, and 32-39 are now pending.

Applicants respectfully request reconsideration of this application based on the following remarks.

Claim Rejections – 35 USC § 103

Claims 1-8, 10-18, 20-27, 29-32 and 34 are rejected under 35 USC § 103(a) as being unpatentable over Ahmad et al. (US Patent No. 2002/0082029) in view of Pepe et al. (US Patent No. 5,742,905). Applicants respectfully traverse this rejection.

As noted above, claims 2, 3, 13, 14, 26, 30 and 31 have been canceled, and thus their rejection is moot.

To establish a *prima facie* case of obviousness, all of the claimed features must be taught or suggested by the references and there must be some suggestion or motivation, in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.²

Ahmad fails to disclose or suggest “transmitting a registration request, from the wireless communications device, over the packet data session to a voice message server to register the wireless communications device to receive a notification of an incoming call from a circuit-switched network, the registration request including connection information identifying the wireless communications device” as recited in Claim 1. Ahmad is silent with respect to this subject matter.

In response to the features disclosed in the original claim 3 now incorporated into amended claim 1, the Examiner sites Ahmad, paragraph [0039]. Ahmad states the following:

To achieve this, using conventional Internet Call-Waiting Servers (ICWSs), the user of the HMS must be a subscriber of such service and typically must register

¹ See, e.g., Specification, Paragraphs [0024] and [0026].

² MPEP, section 2142.

over the Internet with the ICWS for the Internet call-waiting notification. In one embodiment of the invention, the MSC forwards an incoming voice call to the Internet Call-Waiting Server whenever it determines that the HMS is in a data call. The Internet Call-Waiting Server would then notify the subscriber via the Internet and wireless communication link between the ANC and the HMS that a voice call (e.g., 1xRTT network call) is waiting. The subscriber may then choose to accept the voice call as a voice over IP call, suspend the data session with the data network (e.g., 1xEDO) and transition to a voice (e.g., 1xRTT) mode to receive and respond to pages and to accept the call or reject the call. (Emphasis added.)³

Ahmad, paragraph [0039].

As shown, Ahmad discloses that a *user must* subscribe to the ICWS and the *user must* register for this subscription over the internet. "Register" as disclosed in Ahmad is in the context of a user signing up for a subscription to a service, which differs from the "registration request" recited in the above referenced claim language. As noted in the Application, "once the IP address for the VMS 110 is known, the subscriber station 102 may transmit a registration request," and "[t]he registration request may include various information including the IP address for the subscriber station."⁴ Contrary to Ahmad where a *user must* register for a service *over the internet*, the pending Application discloses a subscriber station transmitting connection information to a voice message server over an existing packet data session. Thus, Ahmad fails to disclose or suggest the recited subject matter.

The addition of Pepe fails to cure the above-discussed deficiencies in Ahmad. In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from Ahmad in view of Pepe.

Claims 4-7 and 9-11 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-11 be withdrawn.

Claims 12, 23, 24, 29 and 34-36 include subject matter similar to the subject matter of claim 1. Accordingly, Applicants respectfully request that the rejection of claims 12, 23, 24, 29 and 34 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claims 15-18 and 20-22 depend either directly or indirectly from claim 12. Claims 25-28 depend either directly or indirectly from claim 24. Claims 32 and 33 depend either directly or

³ See, Ahmad, Paragraph [0039].

⁴ See, e.g., Specification, Paragraph [0026].

indirectly from claim 29. Accordingly, Applicants respectfully request that the rejection of claims 15-18, 20-22, 25-28, 32 and 33 be withdrawn.

Therefore, based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-8, 10-18, 20-27, 29-32 and 34 under 35 USC § 103(a) as being obvious over Ahmad in view of Pepe.

Allowable Subject Matter

Claims 28 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants acknowledge with appreciation the Examiner's indication that claims 28 and 33 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 35 and 36 present the features disclosed in claims 28 and 33, rewritten in independent form, including all of the limitations of the base claims.

New Claims

Applicants have added new claims 35-39 to recite subject matter to which they are entitled. As noted above, these new claims are fully supported throughout the Specification.

Furthermore, as noted above, claims 35 and 36 present the features disclosed in claims 28 and 33, rewritten in independent form, including all of the limitations of the base claims

Additionally, claims 37-39 are allowable, as there is no combination of the cited references that discloses or suggests the subject matter recited by these claims.

Further, claims 37-39 respectively depend from one of independent claims 1, 12 or 17, which are believed to be patentable over any combination of the cited references, as discussed above.

Therefore, Applicants respectfully request that the Examiner allow claims 25-35.

Application No. 10/643,604
Amendment dated January 8, 2009
Reply to Office Action of October 8, 2008

CONCLUSION

In light of these remarks, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Date:

1/8/2009

By:



Kristine Ekwueme, Reg. No. 56,344
Direct: (858) 658-1901

QUALCOMM Incorporated
Attn: Patent Department
5775 Morehouse Drive
San Diego, California 92121-1714
Telephone: (858) 658-5787
Facsimile: (858) 658-2502